

REMARKS

Applicant has amended the specification as suggested by the Examiner and rewritten the paragraph on lines 11-19 of page 3 to include a neck formed around the cap as clearly shown in Figures 1,2 and 3. Accordingly, no new matter has been added. Further, Applicant has amended claim 1 to overcome the Examiner's objection.

Claim 1 has been amended to call for a cap at one end of the cover and a neck formed around the cap near a rear end of the cap. Claim 1 has also been amended to clarify that the magnet is for attaching the marker to a white board. Support for this limitation is provided on page 4, lines 1-3 of the specification. Accordingly, no new matter has been entered.

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Korper in view of Dufilho. Claim 2 was also rejected under 35 U.S.C. 103(a) as being unpatentable over Korper in view of Dufilho as applied to claim 1 and further in view of Toyama. Claim 3 was rejected as unpatentable over Korper in view of Dufilho as claimed above and further in view of Shih.

It is respectfully submitted that the cited references do not disclose or suggest a cap at one end thereof with a neck formed around the cap near a rear end of the cap. Accordingly, it is Applicant's contention that amended claim 1 should be allowed.

In rejecting claim 1 the Examiner alleged that Korper's patent disclosed all the limitations of claim 1 of the present application except the magnet chamber in the body to accommodate a magnet inside the magnet chamber. The Examiner went on to state that Dufilho's patent disclosed another marking device having a magnet chamber 26 with the magnet 16. Based on the above, the Examiner asserted that combining the white board marker of Korper and the magnet device in Dufilho to achieve the present application would be obvious to a person of ordinary skill in the art.

It is respectfully submitted that in Dufilho's patent the magnet device in the patent is completely different then the one in the present application. Referring to column 2, lines 13 to 15 of Dufilho it is stated "the magnet would be the north pole" additionally with respect to column 2, lines 30-34 the description said "the compass card 24 is in the shape of a cylindrical cap made of transparent plastic and is closed at its upper end, and open at its lower end. Thus, it may be provided with the usual north

south east and west markings. This card 24 fits snugly over the magnet 16 and moves with the magnet assembly. According to the above description the magnet assembly in Dufilho's patent is a compass as compared to a magnet for attaching the marker to a white board as called for in amended claim 1.

However, with respect to the magnet 22 in the present application, the magnet 22 magnetically attaches the white board marker to a magnet attractive surface (see Fig. 1 in the present application). The magnet serves as an attaching means that is a completely different function than a compass. Therefore, combining Korper's patent and Dufilho's patent would not result in the white board marker of the present application. Further, there is no motivation or suggestion to combine the references in the manner suggested.

Accordingly, it is Applicant's contention that claims 1 and dependent claims 2 and 3 are patentably distinguished over the cited art and should be allowed.

As stated above, the feature of a cap and a neck in amended claim 1 is not shown in either Korper's patent or Dufilho's patent. This neck on the cap makes the cap easier to hold. Therefore, amended claim 1 is patentable.

The Examiner further asserted that claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Korper in view of Dufilho and further in view of Toyama. Further, the Examiner alleges that it would be obvious to combine the air passage of Toyama's patent with the cap of Korper. However, there is no motivation or suggestion in either reference to do so. Accordingly, this rejection should be withdrawn and claim 2 should be allowed.

Further, the Examiner asserted with respect to claim 3 that it would be unpatentable over Korper in view of Dufilho as applied to claim 1 above and further in view of Shih. In Shih's patent, the marker is shaped like a bowling pin. However, claim 1 has been amended to contain the feature of a magnetic attaching means and a neck in the cap which makes claim 1 patentable because of a different function in the magnet. Further, the cited reference does not show a neck in the cap as called for in amended claims 1 and dependent claims 2 and 3. Accordingly, claims 1-3 should be allowed. Therefore, claims 2 and 3 depending on claim 1 should be allowable.

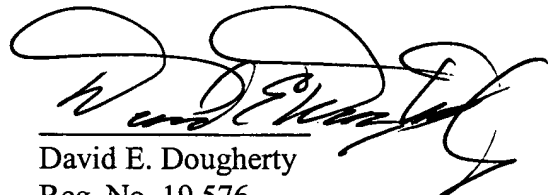
Further, the disclosure of Shih which discloses a bowling pin does not show a neck portion in the cap. By contrast, Shih discloses a neck portion in the body of the device. Accordingly, claims 1-3 are clearly and patentably distinguished over Shih. This is supported by the fact that none of the other references disclose or suggest a cap having a neck portion formed around the cap near a rear end of the cap for convenient holding.

Since all of the claims are now in proper form and clearly and patentably distinguished over the cited art, prompt favorable action is earnestly requested.

Respectfully submitted,

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Date

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